

Atty. Dkt. No. 047711-0331

DAT  
JFW

## THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leif BOWMAN, et al.

Title: SUBCUTANEOUS INFUSION SET

Appl. No.: 10/705,686

Filing Date: 11/10/2003

Examiner: Not Assigned

Art Unit: 3762

CERTIFICATE OF EXPRESS MAILING  
I hereby certify that this correspondence is being deposited with the  
United States Postal Service's "Express Mail Post Office To  
Addressee" service under 37 C.F.R. § 1.10 on the date indicated  
below and is addressed to: Commissioner for Patents, P.O. Box  
1450, Alexandria, VA 22313-1450.

EV 420552180 US Sep. 12, 2004  
(Express Mail Label Number) (Date of Deposit)

Jose Ramos  
(Printed Name)  
JL Ramos  
(Signature)

### PETITION IN SUPPORT OF FILING ON BEHALF OF OMITTED INVENTOR

#### UNDER 35 U.S.C. 116 AND 37 C.F.R. 1.47

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR § 1.47(a), applicants herewith Petition the Commissioner to accept the accompanying Declaration executed by co-inventors Leif Bowman, Milad Girgis, Thomas Rudolph, Fred Houghton, Jason Adams and Brian Highley on behalf of themselves and omitted co-inventor Albert Candiotti.

Applicant has diligently attempted to obtain a signed inventor's Declaration from the above-named omitted co-inventor without success, as documented in the Declaration of Paul Kovelman (Vice President of Intellectual Property and Patent Counsel for the Applicant, Medtronic MiniMed, Inc.) that accompanies this Petition. Therefore, Applicant requests that the Commissioner grant the instant petition and allow the above-named signing co-inventors to pursue the application, as provided by 37 CFR § 1.47(a), on behalf of the above-named omitted co-inventors.

The omitted co-inventor (Albert Candiotti) signed an agreement titled "Employee Invention, Trade Secret And Confidential Information Agreement" (hereinafter referred to as "the Agreement") with MiniMed Inc., agreeing that inventions made during his employment "with MiniMed's equipment, supplies, facilities, trade secrets or time or which relate to the business of MiniMed ..." belong to MiniMed and promising to assign such inventions to MiniMed. A copy of the Agreement is attached to the accompanying Declaration of Paul Kovelman, as Exhibit 1 thereto. In 2001, MiniMed Inc. (including their intellectual property) was acquired by Medtronic Corporation and became Medtronic MiniMed, Inc.. (See Declaration of Paul Kovelman, paragraph 4).

Therefore, the above-referenced Agreement shows that the omitted co-inventor, Albert Candiotti, has a legal obligation to assign all rights, title, and interest in and to the invention described in the above-designated application to MiniMed, Inc.. Also, as shown in the accompanying Declaration of Paul Kovelman, the intellectual property of MiniMed Inc. is now owned by the Assignee of the present application, Medtronic MiniMed, Inc (hereinafter "Applicant").

Applicant made several attempts to obtain Albert Candiotti's signature on documents associated with the present patent application, including an inventor's Declaration document. However, after several attempts, Applicant was unable to obtain his signature.

In particular, an email letter dated July 19, 2004, with attachments (including an inventor's Declaration), were sent to Albert Candiotti. That letter requested that Albert Candiotti review application papers as filed and execute the Declaration. Attached as Exhibit 3 to the accompanying Declaration of Paul Kovelman is a copy of the July 19, 2004, email and a copy of a cover page and a return cover page for an electronic facsimile transmission of documents (drawings) that were sent to Albert Candiotti on the same date and in conjunction with the July 19, 2004 email. In addition, several telephone conversations were conducted with Albert Candiotti during the month of July to arrange for him to sign the inventor's Declaration. (See paragraph 5 of the accompanying Declaration of Paul Kovelman.)

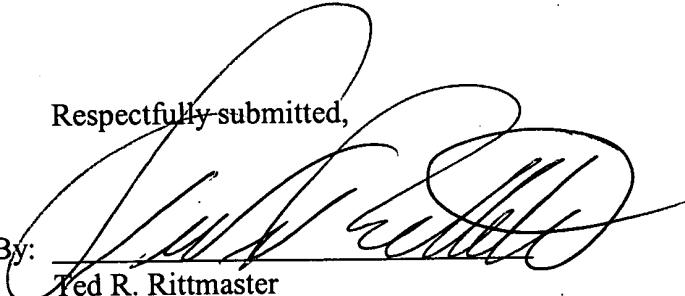
In response to the July 19, 2004 email and telephone calls conducted in July, Applicant did not receive a signed Declaration from Albert Candiotti. Accordingly, Paul Kovelman sent a letter dated August 5, 2004, to Albert Candiotti, enclosing a copy of the subject patent application and other documents (including the inventor's Declaration) and requesting that Albert Candiotti sign and return the Declaration document. A copy of that letter is attached as Exhibit 3 to the accompanying Declaration of Paul Kovelman.

In response to the August 5, 2004, letter, Applicant still did not receive a signed Declaration from Albert Candiotti. However, during the week of August 9, 2004, Albert Candiotti contacted Paul Kovelman by telephone and informed Mr. Kovelman that he (Albert Candiotti) understood his obligation to sign the Declaration document pursuant to his Employment Agreement, but that he would not sign the Declaration document at this time, because he is involved in an on-going dispute with Medtronic-MiniMed, Inc. regarding other matters (see the accompanying Declaration of Paul Kovelman, paragraph 7).

Thus, the foregoing shows that Applicant has made diligent efforts to obtain the signature of Albert Candiotti on the Assignment and inventor Declaration forms. In addition, the foregoing shows that Albert Candiotti apparently refuses to sign the application papers. Therefore, it is requested that the present Petition be granted.

Date: September 10, 2004  
FOLEY & LARDNER LLP  
Customer Number: 23392  
Telephone: (310) 975-7963  
Facsimile: (310) 557-8475

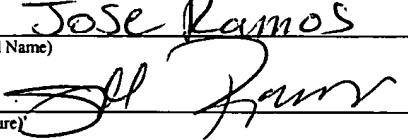
Respectfully submitted,

By:   
Ted R. Rittmaster  
Attorney for Applicant  
Registration No. 32,933

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leif BOWMAN, et al.  
 Title: SUBCUTANEOUS INFUSION SET  
 Appl. No.: 10/705,686  
 Filing Date: 11/10/2003  
 Examiner: Not Assigned  
 Art Unit: 3762

61 - JCT 1068  
 SEP 10 2004  
 TRADEMARK OFFICE

CERTIFICATE OF EXPRESS MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
EX 020552180 US	Sept 10, 2004
(Express Mail Label Number)	(Date of Deposit)
Jose Ramos	
(Printed Name)	
	
(Signature)	

**DECLARATION OF PAUL KOVELMAN IN SUPPORT OF FILING**  
**ON BEHALF OF OMITTED INVENTOR**  
**UNDER 35 U.S.C. 116 AND 37 C.F.R. 1.47**

I, Paul Kovelman, hereby declare as follows:

1. I am submitting this Declaration with the accompanying "Petition In Support Of Filing On Behalf Of Omitted Inventor Under 35 U.S.C. 116 And 37 C.F.R. 1.47." I am Vice President of Intellectual Property and Patent Counsel for Medtronic MiniMed, Inc. Prior to my position at Medtronic MiniMed, Inc., I was Vice President of Intellectual Property and Patent Counsel for MiniMed, Inc.
2. Attached hereto as Exhibit 1 is a copy of a document titled "Employee Invention, Trade Secret And Confidential Information Agreement." That Agreement has been signed by the omitted co-inventor, Albert Candiotti. The omitted co-inventor, Albert Candiotti, was previously employed by Applicant, but ended his employment with Applicant on or about April of 2004.
3. The Agreement titled "Employee Invention, Trade Secret And Confidential Information Agreement" (Exhibit 1 hereto) contains a clause (3) wherein the signing party agrees, *inter alia*, that all inventions made by the Employee during the term of his employment, "which were made with MiniMed's equipment, supplies, facilities, trade secrets or time, or which relate to the business of MiniMed ...or which results from any work performed by Employee for MiniMed ... shall belong to MiniMed." That clause (3) also provides that the

Employee "promises to assign such inventions to MiniMed and to cooperate with MiniMed to obtain patents on the inventions for MiniMed in the United States and all foreign countries."

The first paragraph of that Agreement defines MiniMed as "MiniMed Inc."

4. In 2001, Medtronic Corporation acquired MiniMed Inc. and made Medtronic MiniMed, Inc. therefrom. As part of the acquisition and naming of Medtronic MiniMed, Inc., all of the intellectual property of MiniMed Inc. became owned by Medtronic MiniMed, Inc.

5. My assistant, Christine Pineiro, under my direction, had several telephone conversations with Albert Candiotti during the month of July, 2004, to arrange for him to sign the inventor's Declaration associated with the above-referenced patent application. Also attached as Exhibit 2 hereto is a hardcopy of an e-mail, dated July 19, 2004, sent by my assistant, Christine Pineiro, at Albert Candiotti's request and under my direction. A copy of the specification, an inventor's Declaration and an Assignment document for above-referenced patent application were attached to that email. In the July 19, 2004, email, Albert Candiotti is asked to execute the inventor's Declaration and Assignment documents. Also attached in Exhibit 2 are copies of a facsimile cover page and a return facsimile cover page which were used to forward, by facsimile, a copy of the drawings for the above-referenced application to Albert Candiotti on July 19, 2004.

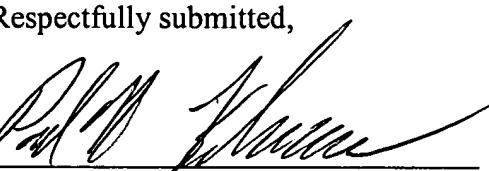
6. In response to the July 19, 2004, email, we did not receive a signed inventor's Declaration from Albert Candiotti. Accordingly, on August 5, 2004, I sent a letter by overnight delivery (Federal Express) to Albert Candiotti, in which I enclosed a copy of the above-referenced patent application, an inventor's Declaration and an Assignment document for Albert Candiotti to review, sign and return. A copy of my letter of August 5, 2004, is attached hereto as Exhibit 3. In that letter, I asked Albert Candiotti to review the application, sign the Declaration and Assignment documents and return the signed documents in an enclosed Federal Express envelope.

7. In response to my letter of August 5, 2004, we still did not receive a signed inventor's Declaration from Albert Candiotti. However, Albert Candiotti contacted me by telephone during the week of August 9, 2004. During that telephone call, Albert Candiotti informed me that he understood that he has an obligation to sign the Declaration document

pursuant to his employment agreement, but that he would not sign the Declaration document at this time, because he is involved in an on-going dispute with Medtronic-MiniMed, Inc. regarding other matters unrelated to the above-referenced patent application.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

By: 

Paul Kovelman  
Vice President of Intellectual Property  
and Patent Counsel for  
Medtronic MiniMed, Inc.

Mailing Address for this Application:  
FOLEY & LARDNER LLP  
2029 Century Park East, 35<sup>th</sup> Floor  
Los Angeles, CA 90067-3021  
Tel: (310) 277-2223  
Fax: (310) 557-8475



# Minimed<sup>®</sup>

## EMPLOYEE INVENTION, TRADE SECRET AND CONFIDENTIAL INFORMATION AGREEMENT

Minimed's success, and the opportunities for all of its employees, depends to a significant degree on the development and preservation of proprietary information and inventions. Accordingly, this agreement is entered into between Minimed and the undersigned Employee to assist in achieving these goals. For purposes of this agreement, "Minimed" means Minimed Inc. and any of its direct or indirect subsidiaries or affiliates.

During the course of Employee's employment, it is expected that Employee may develop, and/or receive from co-workers, "intellectual property," inventions, trade secrets and confidential information relating to Minimed's business and to its actual and anticipated research or development, as well as other "confidential business information." This agreement identifies certain of Employee's obligations with respect to such matters. These obligations are a part of Employee's job responsibilities and, thus, are in consideration for the compensation paid to Employee.

### AGREEMENT

(1) Employee will, during the term of his/her employment and thereafter, keep confidential and refrain from using (other than in connection with Minimed's business) or disclosing to others all confidential information and trade secrets of Minimed which Employee develops or learns about during the course of his/her employment. Employee agrees during and after his/her employment to assist Minimed in all reasonable efforts to maintain trade secrets. It is understood by Employee that confidential information and trade secrets also includes information received from third parties under an obligation of non-disclosure, as well as all proprietary and confidential information developed by or for Minimed.

(2) Employee understands that "confidential business information" includes, but is not limited to, the following with respect to Minimed: agreements or purported agreements of any kind, financial records, customer and vendor names and other information, records pertaining

to customers and vendors, business plans, compensation plans, bonuses and incentive plans and personnel records; and that "intellectual property" includes, but is not limited to, the following with respect to MiniMed: research and development information, laboratory engineering and/or design books, operating methods and procedures, new concepts, electronic and physical data, computer programs and similar items or research projects.

(3) As to all inventions made by Employee during the term of his/her employment, solely or jointly with others, which are made with MiniMed's equipment, supplies, facilities, trade secrets or time, or which relate to the business of MiniMed, or MiniMed's actual or demonstrably anticipated research or developments, or which result from any work performed by Employee for MiniMed, Employee agrees that such inventions shall belong to MiniMed and he/she promises to assign such inventions to MiniMed and to cooperate with MiniMed to obtain patents on the inventions for MiniMed in the United States and all foreign countries. Employee also agrees that MiniMed shall have the right to keep such inventions as trade secrets, if MiniMed chooses. Employee shall promptly disclose to MiniMed in writing all such inventions. Employee agrees to assign to MiniMed his/her rights in any other inventions where MiniMed is required to grant those rights to the U.S. Government or any agency thereof.

(4) This agreement does not apply to any inventions which an employee may not be required to assign to his/her employer under Section 2870 of the California Labor Code.<sup>1</sup>

Signed at SYLMAR, California this 9<sup>TH</sup> day of AUGUST, 1999.

ALBERT D. CANDIOTY

Name (print)

Albert Candiotti

Signed

**RECEIVED**

AUG 09 1999

**MINIMED PERSONNEL**

<sup>1</sup> Sec. 2870. Employment agreements; assignment of rights:

(a) Any provision in an employment agreement which provides that an employee shall assign or offer to assign any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

(1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer.

(2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against public policy and is unenforceable.

(Added by Stats. 1979, c.1001,p.3401, Sec 1. Amended by Stats 1986, c.346, Sec. 1.)

**Pineiro, Christine**

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**From:** Pineiro, Christine  
**Sent:** Monday, July 19, 2004 3:32 PM  
**To:** 'acandioly@sbcglobal.net'  
**Subject:** Documents for Execution for PF01105 US / F&L Ref. 047711-0331  
**Importance:** High

Hi Albert,

Attached is the application as filed. Also attached is the Assignment & Declaration, which are the documents that I need for you (and Milad) to execute. The Assignment simply assigns the invention to Medtronic MiniMed, Inc. The Declaration just declares that the inventor(s) have reviewed & understand the contents of the application.

Unfortunately I do not have the drawings electronically so I am faxing them to you (11 sheets including fax cover sheet).

**Christine Pineiro**  
**Patent Assistant & Senior Paralegal**  
**Medtronic MiniMed, Inc.**  
**phone: (818) 576-5517**  
**fax: (818) 576-6202**

Albert C  
fax  
(818) 576-6202  
15(d)  
Acandioly  
sbcglobal.net

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO 0160  
RECIPIENT ADDRESS 916613621560  
DESTINATION ID  
ST. TIME 07/19 14:35  
TIME USE 02'24  
PAGES SENT 11  
RESULT OK



18000 Devonshire Street  
Northridge, CA 91325-1219  
(818) 576-5517  
(818) 576-6202 (Facsimile)  
[christine.pineiro@medtronic.com](mailto:christine.pineiro@medtronic.com)

**FACSIMILE TRANSMISSION**

**PATENT DEPARTMENT**

**DATE:** July 19, 2004

**TO:** Albert Candiotti  
Advanced Bionics Corporation  
Fax: (661) 362-1560

**FROM:** Christine Pineiro  
Patent Assistant and Senior Paralegal

**RE:** Documents for Execution for PF01105 US / F&L Ref. 047711-0331

**MESSAGE:**

Hi Albert,

Per my email message, enclosed are the drawings that were filed in the above-mentioned U.S. Patent Application on November 10, 2003.

Kind Regards,  
Christine



18000 Devonshire Street  
Northridge, CA 91325-1219  
(818) 576-5517  
(818) 576-6202 (Facsimile)  
[christine.pineiro@medtronic.com](mailto:christine.pineiro@medtronic.com)

**FACSIMILE TRANSMISSION**

**PATENT DEPARTMENT**

---

**DATE:** July 19, 2004

**TO:** Albert Candiotti  
Advanced Bionics Corporation  
Fax: (661) 362-1560

**FROM:** Christine Pineiro  
Patent Assistant and Senior Paralegal

**RE:** Documents for Execution for PF01105 US / F&L Ref. 047711-0331

**MESSAGE:**

Hi Albert,

Per my email message, enclosed are the drawings that were filed in the above-mentioned U.S. Patent Application on November 10, 2003.

Kind Regards,

Christine

A handwritten signature in black ink, appearing to read "Christine".

(11 page(s) including cover page)

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This written message is for the exclusive use of the addressee and may contain confidential, privileged and non-disclosable information. If the recipient of this message is not the addressee, or a person authorized to receive communications on behalf of the addressee for delivery to the addressee, such recipient is prohibited from reading or using this message in any way. If you have received this message in error, please call the sender and destroy the facsimile message.

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Paul H. Kovelman  
Vice President of Intellectual Property  
and Patent Counsel  
(818) 576-5313  
paul.kovelman@medtronic.com

August 5, 2004

Via FedEx

Albert Candiotti  
5955 Rainbow Hill Road  
Agoura Hills, CA 91301

Re: U.S. Patent Application entitled, "Subcutaneous Infusion Set"  
Serial No.: 10/705,686  
Filed: November 10, 2003  
Inventor(s): Leif N. Bowman et al.  
Our Reference: PF01105 US / Attorney Docket No.: 047711-0331

Dear Albert:

Enclosed is a copy of the above-identified patent application that was filed with the United States Patent and Trademark Office on November 10, 2003.

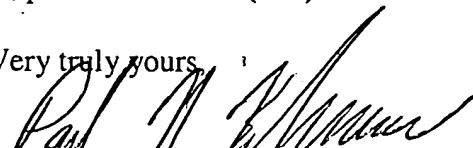
I am enclosing a hard copy of the documents that Christine Pineiro emailed to you on July 19, 2004. I realize that you have been speaking with Rita McConnell in Minneapolis but our deadline to file the Assignment & Declaration is approaching quickly so I need to know if you intend to sign the documents or not. Missing this deadline, will substantially increase our costs.

Please review the enclosed application, and then sign the Declaration and Assignment to Medtronic MiniMed, Inc. Please note that the Assignment needs to be notarized, and if you need reimbursement for the notarization, please enclose a receipt for the notarization fee. Enclosed are: a \$2 bill, and an inventor pen, provided as consideration, for the execution of the documents.

After you have signed the documents, please return the Assignment and Declaration in the enclosed FedEx envelope. Feel free to keep the copy of the application, but remember that it contains confidential and proprietary information and needs to be secured.

If you have any questions or comments, please call me at (818) 576-5313.

Very truly yours,

  
Paul H. Kovelman  
Vice President of Intellectual Property  
and Patent Counsel for Medtronic MiniMed, Inc.

PHK/cp  
Encl.